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Response to Office Action of 13 December 2004

Atty Docket 117163.00032

REMARKS/ARGUMENTS

Claims 1-17 and 19-52 were pending at the time of the mailing of the outstanding Office Action. Claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 were under consideration. By this response, claim 1 is amended. No new claims have been added and no claims have been cancelled.

In the Office Action of 13 December 2004, the Examiner rejected claims 1-3, 5, 21 and 25 under 35 U.S.C. § 102(e) as anticipated by Atala (US2003/0208279). Under 35 U.S.C. § 103(a), the Examiner rejected claims 4, 22-24, and 26-29 as being unpatentable over Atala. Claims 1, 2, 5, 6, 25, and 30 were rejected under 35 U.S.C. § 102(b) as anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Turi (5,556,414). Under 35 U.S.C. § 103(a), the Examiner rejected claims 4, 8, 22-24, 26-29, 32, 34 and 41 as unpatentable over Turi. Claims 31 and 33 were rejected under 35 U.S.C. § 103(a) as obvious over Turi in view of Atala. Claims 14-17 and 51-52 were rejected under 35 U.S.C. § 103(a) as unpatentable over Turi in view of Berg (5,680,873). The Applicants respond as follows.

Claims 1-3, 5, 21 and 25 stand rejected under 35 U.S.C. § 102(e) as anticipated by Atala (US2003/0208279). The Examiner alleges that the stent disclosed by Atala includes, in a first condition, a first part (the main body) of the stent disposed inwardly relative to a second part (the bioactive coating) of the stent. By this amendment, claim 1 has been amended to additionally recite that in a second condition of the stent, at least a portion of the first part of the stent is not disposed inwardly relative to the second part of the stent. Support for this amendment may be found in Figs. 1, 2, 4a and 4b, as well as paragraphs 0055-0056, 0059-0060, and 0067-00669. The Applicants maintain that the cited prior art neither teaches or suggests this element of claim 1 as amended, either independently or together. In Atala, the stent is merely expanded from a first condition to a second condition with no change in the relative position of the first and second parts as classified by the Examiner. Likewise, the Examiner states that Turi provides a stent

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having a configuration where a first part of the stent (26 of Turi, Fig. 1) is disposed inwardly, relative to a second part of the stent (22 of Turi, Fig. 1). However, Turi also provides no indication of or allowance for a change in the relative positions of the first and second parts. Finally, this element is also neither taught nor suggested by Berg, which provides a guide catheter. Therefore, claim 1 patentably distinguishes over Atala, as do claims 2-3, 5, 21 and 25, which depend directly or indirectly from claim 1. Likewise, claims 4, 22-24, and 26-29, which depend directly or indirectly from claim 1, also patentably distinguish over Atala. Furthermore, claims 1, 2, 5, 6, 25, and 30 patentably distinguish over Turi, because Turi does not teach or suggest all of the limitations of claim 1, as detailed above. For the same reason, claims 4, 8, 22-24, 26-29, 32, 34 and 41, which depend directly or indirectly from claim 1, also patentably distinguish over Turi. Because neither Atala nor Turi, alone or in combination, teach or suggest all the limitations of claims 31 and 33, these claims likewise patentably distinguish over these references. Finally, neither Turi nor Berg, alone or in combination, teach or suggest all the limitations of claims 14-17 and 51-52 as described above. Therefore, claims 14-17 and 51-52 also patentably distinguish over the cited prior art.

The Applicants maintain that the present amendment is proper as an amendment after a final office action because the arguments and amendments presented herein could not have been brought earlier. The Examiner's interpretation of the structures of Atala and Turi as being positioned in a way that satisfied the limitation that a first part of the stent is disposed inwardly relative to a second part of the stent was not known prior to the final office action.

In light of the amendments and arguments presented herein, reconsideration of claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 is requested. As the Applicants maintain that generic claims 1-6, 8, 14-17, 21-34, 41, 51, and 52 patentably distinguish over the cited prior art, rejoinder of the non-elected claims of group I, claims 7, 9-13, 35-40 and 42-50, is also requested. The issuance of a Notice of Allowance is respectfully solicited.

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The outstanding Office action was mailed on 13 December 2004. The Examiner set a shortened statutory period for reply of 3 months from the mailing date. Therefore, a response is timely filed on or before 13 March 2005.

No fees are believed to be due with this response. However, in the event that a fee for the filing of his response is insufficient, the Commissioner is authorized to charge any fee deficiency or to credit any overpayment to Deposit Account 15-0450.

Respectfully submitted,



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